



07-09-01

DAC #11

Our Ref.: 146.1309

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:  
JEAN-LUC DUBOIS  
Serial No.: 09/194,996  
Filed: December 4, 1998  
For: TRANSDERMIC...MEDICAMENTS

L.E. Smith

600 Third Avenue  
New York, NY 10016  
July 6, 2001

EL 7177 39846 US  
July 6, 2001

For or too to  
Petition  
under 37 CFR 1.47(b) on the date of filing and  
addressed to the Office of Petitions and Trademarks, Washington, D.C.

July 6, 2001  
D. Wolkowicz

RENEWED REQUEST FOR PETITION UNDER 37 CFR 1.47(b)

RECEIVED

JUL 12 2001

Assistant Commissioner for Patents  
Washington, D.C. 20231

OFFICE OF PETITIONS  
DEPUTY A/C PATENTS

Sir:

Applicants request that the Petition for Acceptance of the above application under Rule 47 be granted. It is noted that the Legal Examiner has indicated that Applicants have complied with Items 1 to 4 and 6 of the Rule, but has held that proof that the Applicant has sufficient proprietary interest in the application has not been established.

Applicants respectfully traverse this holding, since it is believed that Applicants have clearly complied with the fact that Mr. Dubois was required to assign all inventions to Hoechst Marion Roussel during his employment. Applicants have submitted of record the signed the contract between Roussel Uclaf, the predecessor to Hoechst Marion Roussel, and Mr. Dubois and page 2 of the translation clearly states "your studies, research and results are the full and total property of our company". This was filed with the Declaration of Mr. Vieillefosse dated August 31, 1999. Also of record, is a letter indicating that Mr. Dubois was a member of the Hoechst Marion

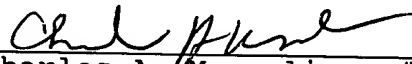
Roussel staff from September 2, 1985 until December 31, 1997. It should be noted that the French application was filed on June 11, 1996 and it was clearly within this period of time. Also of record is the French law indicating that the employee must assign his inventions to the employer during his period of employment. Attention is directed to Mr. Vieillefosse's letter to Mr. Dubois dated December 2, 1998 which indicates that Mr. Dubois had been designated as the inventor of the subject matter filed by Hoechst Marion Roussel, including the French application referred to above. Again, on December 30, 1998, the documents were presented to Mr. Dubois for signature and, as can be seen from Mr. Vieillefosse's earlier Declaration, he had telephone conversations subsequent thereto with Mr. Dubois in which Mr. Dubois absolutely refused to execute the application.

Therefore, it is clear from the record that Mr. Dubois is an inventor of the subject matter of the present application and that it was made within the scope of his employment by Hoechst Marion Roussel. That, from the Declaration of Mr. Vieillefosse of December 28, 2000, it is clear that he was hired as a research executive in the Scientific Division for galenic development research and that the invention was a result of this employment by Hoechst Marion Roussel, falling within the scope of his contract. It should be noted that all these statements by Mr. Vieillefosse have been made under Declaration form and have to be accepted at face value, particularly with the record as it now stands.



Therefore, it is requested that the Patent Office grant the Petition and pass the application to the Group for examination in due course. It should be noted that the application was filed on December 4, 1998 and Applicants' 20 year protection runs from the PCT filing date of June 10, 1997. Therefore, Applicants are losing valuable protection and it is requested that the Petition be immediately granted.

Respectfully submitted,  
BIERMAN, MUSERLIAN AND LUCAS

  
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CAM:sd  
Enclosure: Return Receipt Postcard